

Remarks

Claim 23-29 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Ohno (U.S. 2002/0025443). Further, claims 23-29 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hosoda (US 6,828,000) or Yasuda (US 6,511,788) in view of Ohno.

The above-mentioned rejections are respectfully traversed and submitted to be inapplicable to the claims for the following reasons.

Claim 23 is patentable over Ohno, the combination of Hosoda and Ohno and the combination of Yasuda and Ohno, since claim 23 recites an optical information recording medium including, in part, a reflective layer provided between a substrate and a recording layer, wherein the reflective layer is formed as a film directly on the substrate, and is an aluminum alloy containing at least 1 atom percent and no more than 5 atom percent nickel. The references, either alone or in combination, fail to disclose or suggest the reflective layer as recited in claim 23.

Ohno discloses an optical recording medium having a crystal grain size controlling layer 6 located between a substrate 1 and a reflective layer 5 (See pages 2 and 3, paragraph [0034] and Figure 1). Further, Ohno discloses that the inclusion of the crystal grain size controlling layer 6 is the main feature of the optical recording medium because it was found that the inclusion of the crystal grain size controlling layer 6 results in an improvement in the surface properties of the reflective layer 5 and a reduction in noise from the optical recording medium. (See page 2, paragraph [0017]).

Ohno also discloses that when the crystal grain size controlling layer 6 is included between the substrate 1 and the reflective layer 5, the reflective layer 5 can include nickel in the amount of 5 atomic % or less. The inclusion of nickel is indicated as being acceptable due to the fact that the crystal grain size controlling layer 6 improves the surface properties of the reflective layer 5 which would otherwise be degraded due to the inclusion of nickel. (See page 4, paragraph [0054]).

Based on the above discussion of the disclosure of Ohno, it is apparent that the inclusion of nickel in the reflective layer 5 is premised on the inclusion of the crystal grain size controlling layer 6 between the reflective layer 5 and the substrate 1. Therefore, Ohno, in fact, teaches away from having a reflective layer including nickel in an amount of at least one atom percent and no more than five atom percent formed directly on a substrate. Further, it is noted that the Federal

Circuit has stated that if, in order to meet the limitations of a claim, a device in a prior art patent would have to be modified in a manner as to render it inoperable for its intended purpose, then in effect, that patent teaches away from the proposed modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). As a result, claim 23 is patentable over Ohno.

Regarding the combinations of Hosoda and Yasuda with Ohno, it is noted that both Hosoda and Yasuda are relied upon as disclosing a reflective layer located directly on a substrate. (See Figure 2 of Hosoda and Figure 33 of Yasuda). However, as admitted in the rejections, neither of these references discloses or suggests that the reflective layer is an aluminum alloy containing at least 1 atom percent and no more than 5 atom percent nickel.

In order to address this deficiency of Hosoda and Yasuda, the rejections again rely on the disclosure in Ohno that a reflective layer can include nickel in the amount of 5 atomic % or less. (See page 4, paragraph [0054]). However, as discussed above, the inclusion of nickel in the reflectively in Ohno is premised on the utilization of the crystal grain size controlling layer 6 to compensate for the effect of the nickel. Therefore, Ohno, in fact, teaches away from having a reflective layer including nickel in an amount of at least one atom percent and no more than five atom percent formed directly on a substrate. It would not have been obvious to one of ordinary skill in the art to combine the references in the manner suggested in the rejections. As a result, claims 23 is also patentable over the combination of Hosoda and Ohno and the combination of Yasuda and Ohno.

As for claim 29, it is submitted to be patentable over the references relied upon in the rejections for reasons similar to those set forth above with regard to claim 23.

Because of the above-mentioned distinctions, it is believed clear that claims 23-29 are allowable over the references relied upon in the rejections. Furthermore, it is submitted that the distinctions are such that a person having ordinary skill in the art at the time of invention would not have been motivated to make any combination of the references of record in such a manner as to result in, or otherwise render obvious, the present invention as recited in claims 23-29. Therefore, it is submitted that claims 23-29 are clearly allowable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that there are issues remaining which must be resolved before allowance of the application.

Respectfully submitted,

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